

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ADAM MICHAEL ESPESETH,
ROBERT ANTON STEINBACH and
TREVOR JAMES BRIGGS

Appeal 2007-0915
Application 10/764,946¹
Technology Center 2100

Decided: November 16, 2007

Before RICHARD TORCZON, SALLY C. MEDLEY, and MARK NAGUMO, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION ON REHEARING

1 Applicants request rehearing under Bd.R. 41.52. A request for rehearing must state with particularity points believed to have been

11 Application for patent filed 26 January 2004. The real party in interest is Hitachi Global Storage Technologies, Netherlands, B.V.

3Appeal 2007-0915

4Application 10/764,946

5

1misapprehended or overlooked. Arguments not raised in the briefs are not
2permitted in the request for rehearing. 37 C.F.R. § 41.52(a)(1).

3 In our decision, we stated the following:

4 Claim 1, when properly interpreted, requires selection of
5 a command to be executed based on at least one of (1) an
6 optimized throughput benefit, which is determined based at
7 least in part on a pipe length, or (2) an optimized operation rate
8 benefit². Claim 1 does not require selection of the command
9 based on both an optimized throughput benefit and an
10 optimized rate benefit. Applicants apparently agree with this
11 interpretation.

12 A reference that describes either an optimized throughput
13 benefit (determined based at least in part on a pipe length) or an
14 optimized operation rate benefit meets the optimized limitation.

15 Applicants' arguments are with respect to the "optimized
16 throughput benefit" limitation, e.g., whether Clegg describes an
17 optimized throughput benefit that is determined based on pipe
18 length. Applicants are silent with respect to whether Clegg
19 describes an "optimized operation rate benefit." Since
20 Applicants have failed to sufficiently demonstrate that the
21 Examiner's findings that Clegg describes an "optimized
22 operation rate benefit" are erroneous, the Examiner's rejection
23 of claim 1 is affirmed.

24

25 Applicants contend that, contrary to our decision, they did argue that
26 Clegg failed to teach the "optimized operation rate benefit element"
27 directing attention to the bottom of page 4 of their brief.

28 The portion of Applicants' brief that Applicants contend we
29 overlooked is underlined and is contained in the following passage:

62 References to finding of facts omitted.

7

8

11

1 The examiner has responded to the above explanation of Clegg
2 et al. with a citation to the present specification. The present
3 specification is not part of the prior art. The examiner attempts
4 to draw parallels between the relied-upon portions of
5 Appellant's own specification and Clegg et al., col. 2, line 55 to
6 col. 3, but must do so only by a leap of logic: "thus it is
7 advantageous to access sequential data blocks all together."
8 But still length is not implicated. The above quoted portion of
9 the final rejection is followed by what appears to be another
10 leap: "The length of the data blocks corresponding the pipe
11 length in the claims" (sic). As best understood, the examiner
12 appears to be alleging that because sequential data blocks in
13 Clegg et al. inherently have a length, then that equates to an
14 actual suggestion to use the length to determine a throughput
15 benefit as required by Claim 1, but of course this is simply a
16 restatement of the syllogism that proximity equals length, the
17 falsity of which has been revealed above.
18

19 Applicants argue that by referring to the portion of Clegg, e.g., col. 2,
20 line 55 to col. 3 that the Examiner relied on as describing the operation rate
21 benefit limitation, that Applicants "plainly took issue with how the examiner
22 interpreted the portion of Clegg relied on for the optimized operation rate
23 benefit element" (Request for Rehearing at 1-2).

24 We are not persuaded. Reading the above passage *in totality*, one
25 would understand Applicants to argue that Clegg does not teach the
26 throughput benefit limitation and not the optimized operation rate benefit
27 limitation as now asserted.

28 The Examiner's reliance on Clegg col. 2 line 55 to col. 3 that is
29 referred to in the above passage was apparently in response to Applicants'
30 argument that Clegg fails to teach "wherein the throughput benefit is

12

13

14Appeal 2007-0915

15Application 10/764,946

16

1determined based at least in part of a pipe length” and not the optimized
2operation rate benefit limitation (Answer at 6, section “A”). It is not facially
3apparent that Applicants reference to Clegg col. 2, line 55 to col. 3 and the
4“leap of logic” comment from the above passage were directed to the
5optimized operation rate benefit as asserted. If anything, one would
6understand the “leap of logic” comment to be in response to the Examiner’s
7findings with respect to the “throughput benefit” limitation.

8 From the above passage, and following the reference to col. 2 line 55
9to col. 3 of Clegg, Applicants argue “but still length is not implicated.” By
10using the conjunction “but” immediately following the specific reference to
11Clegg, we understand the reference to “still length is not implicated” to be in
12reference to the cited Clegg passage. We understand Applicants to argue
13that the specific passage in Clegg does not implicate the “pipe length” which
14is associated only with the optimized throughput benefit, and not the
15optimized operation rate benefit. Thus, we disagree that Applicants “plainly
16took issue with how the examiner interpreted the portion of Clegg relied on
17for the optimized operation rate benefit element” as asserted. All signs point
18to just the opposite – that Applicants did not take issue with the “optimized
19operation rate benefit limitation,” but only with the “throughput benefit”
20limitation.

21 For these reasons, Applicants have failed to demonstrate that we
22misapprehended or overlooked an argument made in its brief.

23 The Decision on Appeal correctly notes that claims 1 and 5 stand
24rejected and are the subject of appeal (Decision on Appeal at 2:5-6; 2:14-16;

17

18

19Appeal 2007-0915
20Application 10/764,946
21

12:23 and 6:2-4). However, as pointed out by Applicants, the decision
2incorrectly includes claims 2-4 and 7-20 under the heading “Statement of the
3Case” (Decision on Appeal at 1:3). Accordingly, the Decision on Appeal is
4modified as follows: page 1, line 3 “claims 1-5 and 7-20” should read
5“claims 1 and 5”. No other changes will be made.

6 CONCLUSION

7 Applicants' request for rehearing is granted to the extent that our
8 original decision of May 21, 2007 is modified as noted in this decision.
9 Otherwise, the request is denied.

10 No time period for taking any subsequent action in connection with
11 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2004).

GRANTED-IN-PART

1b

22
23

24Appeal 2007-0915

25Application 10/764,946

26

cc (U.S. Mail):

John L. Rogitz, Esquire
Rogitz & Associates
750 B Street, Suite 3120
San Diego, CA 92101

27

28